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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/671,341 | 09/25/2003 | Stephen A. Baum | P-26,015 US1 | 7066 |

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| EXAMINER |
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GROSS, CHRISTOPHER M

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| ART UNIT | PAPER NUMBER |
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1639

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/18/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|----------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/671,341 | BAUM, STEPHEN A. | |
| | Examiner | Art Unit | |
| | Christopher M. Gross | 1639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46,47,49-51,54,56-58 and 60-85 is/are pending in the application.
- 4a) Of the above claim(s) 57,59 and 63-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 46,47,49-51,54,56,58 and 60-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Responsive to communications entered 12/19/2006. Claims 46-47,49-51,54,56-58, 60-85 are pending. Claims 57,59, 63-85 are withdrawn. Claims 46,47,49-51,54,56,58,60-62 are examined herein.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/19/2006 has been entered.

Election/Restrictions

Newly submitted claims 66-85 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The restriction requirement mailed 9/7/2004 required an election of a support transfer device. Election by applicant entered 1/10/2005 was that of a "rack" having a plurality of rods sized to be inserted through an aperture formed in each support and a mechanism to prevent the supports from coming off the rack, whereas newly added claims 66-75 are drawn to a vacuum manifold and newly added claims 76-85 are drawn to a slidable gate.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 66-85 are withdrawn from consideration

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as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim 57 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The restriction requirement mailed 9/7/2004 required an election of the composition and shape of the solid supports. Election by applicant entered 1/10/2005 was that of a polypropylene sphere.

During a telephone conversation with Peter Mlynek on 12/27/2006 it was agreed that claim 57, as amended on 12/19/2006, no longer reads on a polypropylene sphere.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 57 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 120 is acknowledged: this application is a DIV of 09/082,038 05/20/1998 (now PAT 6,872,535).

Withdrawn Claim Rejections

The obviousness-type double patenting rejection of claims 46-47, 49, 51 and 54-58 over claims 1-12 of U.S. Patent No. 6,541,211, has been withdrawn in view of applicant's amendments to the claims.

The rejection of claims 46-47, 49-51 and 54-58 under 35 U.S.C. 103(a) as being unpatentable over **Campbell** US Pat. No. 6,083,682 (7/00: filed 12/97) in view of any of

Nova et al. US Pat. No. 5,961,923 (10/99: filed 9/96 or earlier), **Moran et al.** WO 97/35198 (9/97: filed 3/96) or **Lebl et al.** US Pat. No 6,045,755 (4/00: filed 3/97) has been withdrawn in view of applicant's amendments to the claims.

Maintained Claim Rejections - 35 USC § 103

Claims 46-47, 49-51, 52-56, 58, 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Campbell** US Pat. No. 6,083,682 (7/00: filed 12/97) in view of **Moran et al.** WO 97/35198 (9/97: filed 3/96) as evidenced by Valerio et al (1993 Int. J. Peptide Protein Res. 42:1-9). This rejection maintains the reasons set forth in the previous Office action.

Please note that the above statement of rejection has been modified from the original version to more clearly address applicants' newly amended and/or added claims and/or arguments.

Response to Arguments

Applicant argues (i) not all elements are taught; (ii) prior art devices are not physically combinable.

Applicants arguments have been considered but they are not persuasive for the following reasons.

(i) Applicant argues, see pp 13-14 (12/19/2006), that the solid phase supports of Moran are crowns which comprise a "void" rather than an aperture as set forth in the currently amended claims. It is noted, however, that the aperture of the instant case, as well as, said crown "void," both represent a type of hole.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., apertures extending completely through the solid supports) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues, see p 14 (12/19/2006), that Moran does not suggest a plurality of crowns, however applicant's attention is respectfully invited to pg 18, line 1 where Moran et al employ multiple crowns an 8x8 array format, as mentioned in the last office action.

(ii) In response to applicant's argument that the devices of Campbell and Moan are not physically combinable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, assuming arguendo that the fact that 8x8 array of crown holder rods per Moran et al can not reach completely into the columns of the apparatus of Campbell held patentable weight, it is noted that at least one layer of solid-phase supports is accessible to the array of crown holders per Moran and therein may be inserted through the aperture/void/hole of the crowns present on the top layer.

New Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 46-47,49-51,54,56,58,60-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. 37 CFR 1.118 (a) states that "No amendment shall introduce new matter into the disclosure of an application after the filing date of the application".

Amended claim 46 is directed to a method wherein a support transfer device is a rack comprising a plurality of rods sized to be inserted through an aperture formed in each support, whereas claim 52 as originally filed was drawn to a support transfer device comprising rack having a plurality of rods sized to be inserted through an aperture formed in each support *and a mechanism to prevent the supports from coming off the rack.*

Furthermore the specification as originally filed provided no implicit or explicit support for a rack-based support transfer devices lacking a mechanism to prevent the supports from coming off the rack . Similarly, the priority document (US Patent

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6,872,535) does not provide any implicit or explicit support for a rack-based support transfer devices lacking a mechanism to prevent the supports from coming off the rack.

Applicants are reminded that it is their burden to show where the specification supports any amendments to the claims. See 37 CFR 1.121 (b)(2)(iii), the MPEP 714.02, 3rd paragraph, last sentence and also the MPEP 2163.07, last sentence. MPEP 2163.06 notes "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." MPEP 2163.02 teaches that "Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application. MPEP 2163.06 further notes "When an amendment is filed in reply to an objection or rejection based on 35 U.S.C. 112, first paragraph, a study of the entire application is often necessary to determine whether or not "new matter" is involved. *Applicant should therefore specifically point out the support for any amendments made to the disclosure.*

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 46-47,49-51,54,56,58,60-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 46 recites the limitation "each support " in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 47 recites the limitation "said plurality of supports" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 49 recites the limitation "the plurality of supports" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 50 recites the limitation "from selected supports" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 51 recites the limitation "the plurality of supports" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 54 recites the limitation "the plurality of supports" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim 60 recites the limitation "the supports" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Please note that of the above rejections under 35 USC 112 second paragraph are due to amendments to the claims inserting the phrase 'solid phase support' in lieu of 'support' The Examiner agrees with applicant that solid-phase support is more precise language and applicant is encouraged to address the above lack antecedent basis rejections using the term solid-phase support, albeit more consistently.

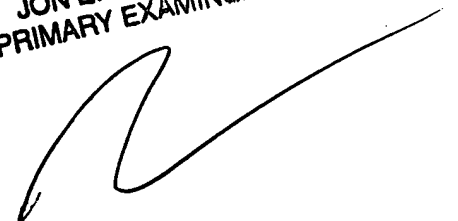
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Douglas Schultz can be reached on 571 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

**JON EPPERSON
PRIMARY EXAMINER**



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